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AUG 20 2004

OFFICE OF PETITIONS

In re Application of :
Bowling and Adams :
Application No. 10/630,290 : DECISION REFUSING STATUS
Filed: 30 July, 2003 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 10326-0001 :
33,212 :

This is in response to the petition filed under 37 CFR 1.47(a)¹ on 30 July, 2003.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 30 July, 2003, with a declaration naming Michael Bowling and Phil Adams as joint

¹A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign. Accordingly, the petition will be treated as a petition under 37 CFR 1.47(a).

inventors and signed by joint inventor Bowling and by petitioner's counsel on behalf of joint inventor Adams. The present petition was also filed on 30 July, 2003. Petitioners' counsel asserts that a copy of the application was sent to the non-signing inventor, but that the inventor returned the application papers along a statement stating that the non-signing inventor was refusing to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2).

In regards to item (1), in the event that the non-signing inventor refuses to sign the declaration, petitioners must present proof thereof. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts. If the application is returned as undeliverable, petitioners should present a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office.

Petitioners should provide, with any renewed petition, a copy of the statement in which the non-signing inventor refuses to sign the declaration.

With regards to item (2), the declaration submitted with the present petition is defective in that if at least one inventor signs the declaration, there is no provision in the rules or laws for counsel or another individual to sign the declaration on behalf of the non-signing inventor. Rather, all the signing inventors must sign the Declaration under 37 CFR 1.63 on behalf

of themselves and on behalf of the non-signing inventor(s). The Declaration is acceptable if all the signing inventors signed in their respective signature blocks and the signature block of the non-signing inventor is left blank or all the signing inventors sign a statement saying that they are signing on behalf of the non-signing inventor. The declaration is not acceptable if there are two or more signing inventors and only one of the signing inventors signed on behalf of the non-signing inventor.

Since a proper oath or declaration was not present on filing, the late oath or declaration or filing fee surcharge of \$65.00 (small entity) is due and will be charged to counsel's deposit account, No. 13-3403, as authorized on the fee transmittal sheet.

The Office is construing the address provided on the declaration as the non-signing inventor's last known address. Petitioners **must** notify the Office if this is not a correct interpretation.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petitions
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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